

ATTACHMENT - REMARKS

By this Amendment, independent claim 15 has been amended to further claim the present invention and to better define the invention over the prior art. Dependent apparatus claim 11 has also been rewritten as an independent claim, with claim 13 thus dependent therefrom and amended consistently therewith. It is submitted that the present application is in condition for allowance for the following reasons.

Initially in the *Claim Rejections - 35 USC § 102* section of the DETAILED ACTION, dependent apparatus claim 11 was rejected under 35 USC § 102 as being anticipated by the Hill patent. However, this rejection was evidently based on ignoring the functional limitations recited in method claim 15 from which claim 11 depended. In order to have those functional limitations considered, apparatus claim 11 has been rewritten in independent form with the functional limitations now part of the recited "means" elements. Since those functional limitations should now be considered just like the similar step/functional limitations of independent claim 15, it is evident that the Hill patent no longer anticipates amended claim 11 (and that the allowability of independent apparatus claim is now similar to that of amended independent method claim 15).

Subsequently in the Action under the *Claim Rejections - 35 USC § 103* section, independent method claim 15 (and various dependent claims) was rejected under 35 USC § 103 as being obvious over:

- a) the principal MacKenzi '385 in view of Hill;
- b) the principal MacKenzi '385 in view of Hill and further in view of Fletcher;
- c) the principal MacKenzi '385 in view of Hill and further in view of Cho.

However, for the following reasons, it is submitted that amended independent method claim 15 (and independent apparatus claim 11) is allowable over these combinations of references.

Initially, it will be appreciated that independent claim 15 has been amended to particularly recite that in the contacting step a first region of the substrate is directly contacted with a contact structure which neutralizes the homogeneous surface tension at the first region to the normal surface tension. Support for this additional limitation is found at least at the last full paragraph on page 3 of the present specification.

In the outstanding Action at lines 7 and 8 of page 4, the examiner states that MacKenzi '385 teaches the reduction of the surface tension by direct contact with a contact structure and points out that the contact structure is realized by a photoresist. However, in the last sentence on page 9, the examiner admits that MacKenzi '385 and Hill do not teach the reduction of the surface tension by contacting with a contact structure as was previously and still is claimed. Accordingly, the examiner then rejects method claim 15 as noted above by first adding Fletcher to the noted combination of MacKenzi '385 in view of Hill; and thereafter alternatively by adding Cho to the noted combination of MacKenzi '385 in view of Hill.

Fletcher discloses a roller having an outer textured cylindrical surface which applies a non-uniform charge pattern over the surface of a sheet of material (e.g., paper) used in xerographic transparencies. The charge applied over the sheet material is of a polarity opposite to that of the charge applied to the conveying structure, so that an electrostatic tacking force holds the sheet material on or adheres the sheet material

to the conveying structure. As noted before, this teaching hardly seems applicable to the processes disclosed in MacKenzi '385 or in Hill except with hindsight.

Cho teaches a method of forming patterned structure by creating a pattern area on the substrate with a roller. Accordingly, Cho discloses the application of an additional layer on the substrate.

The present invention as now claimed in amended independent claim 15 thus differs from all of the prior art documents in that the reduction of the surface tension in certain areas of the substrate is not achieved by applying an additional layer or charge. Rather, the reduction of the surface tension according to the present invention is achieved by contacting the substrate directly with a contact structure, whereby the previous activation of the surface at this location is neutralized back to the normal surface tension. As evident from the above, this feature of the present invention is neither disclosed nor made obvious by any of the cited references.

Therefore, for all of the foregoing reasons, it is submitted that amended independent claim 15 is not made obvious by the combination of MacKenzie '385 and Hill singly or in combination with Fletcher or Cho so that independent claim 15 is now allowable. And for at least these same reasons, it is submitted claims 7-10 and 14 dependent from independent claim 15 are similarly allowable.

It is further submitted that independent apparatus claim 11 which similar claims the above noted features of method claim 15, is also neither disclosed nor made obvious by the noted combinations of references so that independent claim 11 and claim 13 dependent therefrom are likewise allowable.

It is noted that dependent method claims 7 and 9-10 were also rejected individually as being obvious over MacKenzi '385 in view of Hill together with another respective reference. However, as noted above, it is submitted that these dependent claims are allowable at least for the same reasons as independent method claim 15 from which they depend.

For all of the foregoing reasons, it is submitted that the present application is in condition for allowance and such action is solicited.

Respectfully submitted,

Date: October 20, 2009

Signed By
Attorney of Record

/Douglas E. Jackson/

Name: Douglas E. Jackson
Registration No.: 28,518

STITES & HARBISON PLLC ♦ 1199 North Fairfax St. ♦ Suite 900 ♦ Alexandria, VA 22314
TEL: 703-739-4900 ♦ FAX: 703-739-9577 ♦ CUSTOMER NO. 881